

## REMARKS

Claims 1-52 are pending in this application. Claim 10 is amended herein.

Claims 1 and 27 are independent.

Claim 10 is amended in a non-narrowing manner to correct and inadvertent editorial error, and not for purposes of patentability.

The Examiner's effort to clarify the motivation for the proposed modifications to the applied prior art is noted with appreciation. The undersigned wishes to emphasize that he would be more than happy to participate in a telephonic or personal interview at the Examiner's convenience, if the Examiner feels it would be helpful in progressing this case to issuance.

The finality of the rejection is respectfully traversed. As noted in an earlier response, MPEP §707.07 requires that "before a final rejection is in order a clear issue should be developed between the Examiner and applicant." Indeed, the Manual states that "the references should be fully applied" (emphasis added), so as to deal justly with the applicant as well as the public. The Manual goes on to state that "present practice does not sanction hasty and ill-considered...rejections". "The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end." "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible..."(emphasis added).

In relevant part, MPEP § 707.07(g) instructs an Examiner that "[w]here a major technical rejection is proper, it should be stated with a full development of reasons

rather than by a mere conclusion coupled with some stereotyped expression" (emphasis added). Omnibus rejections are to be avoided. Hence, a plurality of claims should never be grouped together in a common rejection, unless that rejection is applicable to all the claims in the group. (See MPEP §707.07(d))

As is detailed below, It is respectfully submitted that the rejection fails to comply with MPEP §707.07 on various grounds. Accordingly, the finality of the rejection is improper. Therefore it is respectfully requested that the finality of the rejection be reconsidered and withdrawn.

Claims 1-52 stand rejected under 35 USC §103(a), as obvious over Thomas et al. (U.S. Patent No. 6,173,272). The rejection is respectfully traversed.

For reasons set-forth below, it is respectfully submitted that no *prima facie* basis for the rejection has been establish. Further, the proposed modifications to the applied prior art are unmotivated. Additionally, numerous features recited in the pending claims are neither taught nor suggested by the applied prior art. Further still, because applicant has not received the full and fair hearing to which applicant is entitled, applicant has been denied the due process mandated under the Constitution of the United States of America.

The traversal arguments presented in the request for reconsideration filed on March 20, 2003 are incorporated herein in their entirety.

Independent claim 1 recites a method for making payments across multiple payment networks. Included in these multiple payment networks is a first payment network having a first payment service provider and a plurality of associated payers and

payees, and a second payment network having a second payment service provider and a plurality of associated payers and payees.

As now understood, the Examiner construes the claim such that the recited multiple payment networks correspond to networks, each of which includes an individual bank and its banking customers who are payers and payees. Thus, according to the Examiner, the first payment network includes a first bank (which the Examiner considers to be a first payment service provider) and its associated bank customers (who the Examiner considers to be a plurality of associated payers and payees), and the second payment network includes a second bank (which the Examiner considers to be a second payment service provider) and its associated bank customers (who the Examiner considers to be a plurality of associated payers and payees).

According to the method of claim 1, a request to make a payment, on behalf of a payer, to a payee not associated with the first payment network is received at the first payment service provider.

As understood, the Examiner views this recital as being met by the first bank receiving a request to make a payment on behalf of one of its associated bank customers (a payer customer) to a payee which is not one of its associated bank customers (i.e. a customer associated with a second bank).

According to the method of claim 1, a request of the first payment service provider is transmitted to determine a payment network within the multiple payment networks with which the payee is associated.

As understood, the Examiner (relying on the disclosure in column 4, lines 35-55, of Thomas) views this recital as being met by the first bank (i.e. the payer's bank)

transmitting a request with the payees unique ID to the TTP, which identifies the RTN of the second bank (i.e. the payee's bank) and thereby identifies a second payment network within the multiple bank networks with which the payee is associated.

According to the method of claim 1, information indicating that the payee is associated with the second payment network is received [implicitly by the first payment service provider (see below)].

As understood, the Examiner views this recital as being met by the disclosure in column 4, lines 35-55, and column 8, lines 47-49, and 56-57, of Thomas.

However, as disclosed in column 4, the TTP determines, based on the unique ID, the name and address of the payee and the RTN of the second bank, and uses this information to transfer the funds. Hence, in Thomas there is no, and there is no need for, the receipt (let alone receipt by the first payment service provider) of information indicating that the payee is associated with the second bank (i.e. that the payee is associated with a second payment network). It appears that the omnibus rejection presented in the final Official Action completely ignores this limitation.

According to the method of claim 1, a payment instruction from the first payment service provider is also transmitted to the second payment service provider to make the payment to the payee. Implicit in this recital is (i) that the transmittal of the payment instruction from the first payment service provider occurs after the information, which indicates that the payee is associated with the second payment network, is received, and (ii) that the information indicating that the payee is associated with the second payment network be received by the first payment service provider. Otherwise, the

identity of the payee's payment service provider would be unknown to the first payment service provider.

Here again, as understood, the Examiner views this recital as being met by the disclosure in column 4, lines 35-55, and column 8, lines 47-49, and 56-57, of Thomas.

However, as disclosed in column 4 and discussed above, the TTP determines, based on the unique ID, the name and address of the payee and the RTN of the second bank, and uses this information to complete the ACH transfer of the funds to the payee's account at the second bank (see Figure 2A and column 14, line 66, through column 15, line 17). Hence, in Thomas there is no, and there is no need for, transmission of a payment instruction from the first bank (or from a first payment service provider) to the second bank (or to a second payment service provider) to make the payment to the payee. Indeed, as is clear from Figure 2A, there are no transmissions of payment instructions from the payer bank to the payee bank. Rather, in Thomas, the transmittal of the payment instruction from the payer bank (i.e. which the Examiner contends to be a first payment service provider) is only to the TTP (not to the payee bank). Furthermore, this transmittal also occurs prior to the information, which indicates that the payee is associated with the payee bank (i.e. which the Examiner contends to be a second payment service provider) even being determined by the TTP (i.e. before the identity of the payee's bank is determined by TTP and without the payee's bank being known to the payer's bank.

As disclosed in column 13, lines 41-62, Thomas in fact teaches against allowing information indicating that the payee is associated with the second bank (or a second payment network), to be received by or otherwise disclosed to the first bank (or a first

payment service provider). Indeed, in the paragraph bridging columns 3 and 4, Thomas discloses that his objective is to utilize the unique ID to avoid the disclosure of such information to the payer or first bank.

Here too, it appears that the omnibus rejection presented in the final Official Action completely ignores these limitations. Additionally, the application of Thomas as proposed is inconsistent with Thomas' own explicit teachings and would render Thomas unable to accomplish its primary objective.

Independent claim 27 is directed to a system for making payments across multiple payment networks including a first payment network having a plurality of associated payers and payees, and a second payment network having a plurality of associated payers and payees. The system includes a first payment processing station associated with the first payment network configured to:

- 1) receive a request to make a payment on behalf of a payer to a payee not associated with the first payment network,
- 2) to transmit a request to determine a payment network within the multiple payment networks with which the payee is associated,
- 3) to receive information indicating that the payee is associated with the second payment network, and
- 4) to transmit a payment instruction to the second payment network to make the payment to the payee.

As has been discussed in detail above, Thomas lacks any teaching or suggestion

of the payer bank receiving information indicating that the payee is associated with the payee or second bank (or a second payment network), or transmitting a payment instruction to the payee bank (or a second payment network) to make the payment to the payee. In fact, providing the first payment processing station required by claim 27 would be inconsistent with Thomas' teaching and render Thomas unable to meet its primary objective.

The claim 27 system also includes a second payment processing station associated with the second payment network which is configured to receive the transmitted payment instruction.

Here again, as has been discussed in detail above, Thomas lacks any teaching or suggestion of the payee bank receiving a payment instruction transmitted by the payer bank. Since this would require that information be made available to the payer bank, which Thomas explicitly teaches should not be made available to the payer bank, having the second payment processing station required by claim 27 would also be inconsistent with Thomas' teaching and render Thomas unable to meet its primary objective.

Thus, the Examiner has failed to make the factual determinations required by Graham v. John Deere Co. of Kansas City (148 USPQ 459 (1966)).

Clearly, one having ordinary skill in the art would not have been led to modify the applied prior art to arrive at the claimed invention, since to do so would be contrary to the applied arts own explicit teachings and would render the applied art unable to accomplish its stated purpose. Thus, there is no teaching, suggestion or inference in the prior art as a whole, which could possibly led to the proposed modifications.

The only basis one would have to modify the applied art as proposed by the Examiner, is the Applicants' disclosure. Thus, the rejection has made without consideration of all the objective evidence bearing on the issue of obviousness, and whether one having ordinary skill in the art would have found the claimed invention, as a whole, obvious.

In this particular case, the Examiner has apparently failed to recognize the fact that the prior art could not be modified so as to result in the combination defined by the claims, without contradicting the applied art's own teachings and rendering it unable to meet its primary objective. The prior art not only fails to suggest the desirability of the Examiner's proposed modification, but in fact teaches against them. Thus, the applied art would not have made the proposed modification obvious (See In re Deminski, 230 USPQ 313 (Fed. Circ. 1986) and In re Fritch (23 USPQ 1780 (Fed. Circ. 1992))).

Unquestionably, the prior art did not make obvious the invention, as a whole, for which patentability is claimed. The Examiner has not even established that each claimed element is found somewhere in the applied prior art, let alone that the invention as a whole is obvious (See Hartness International, Inc. v Simplimatic Engineering Co. (2 USPQ 2d 1826 (Fed. Circ. 1987))).

The record in this case establishes that the Examiner has opted to rely on simplicity and hindsight rather than the proper criteria for resolving obviousness (In re Warner, 154 USPQ 173 (CCPA 1967)). Based on the objective evidence, there is no possibility that the applied prior art could be modified so as to result in the combination defined by the claims. Furthermore, there is no objective basis which could support a conclusion that the applied prior art would have made the proposed modifications

desirable or obvious, since the proposed modifications are inconsistent with the prior art's own teachings and stated purpose. Since any such suggestion of the proposed modification is absent, the basis for the rejection can only be viewed as nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide (See In re Deminski supra).

Even if the applied prior art could be modified so as to result in the combination defined by the claims (which it is respectfully submitted is not the case, as evidenced above), the applied prior art itself expressly teaches against the Examiner's proposed modification, and therefore also teaches that such modifications are undesirable and would not have been obvious (See In re Gordon 221 USPQ 1125 (Fed. Circ. 1984), and In re Keller 208 USPQ 817 (CCPA 1981)).

The deficiencies in the applied art here cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sense. (See In re Lee 61 USPQ 2d 1430 (Fed. Circ. 2002)).

Accordingly, it is respectfully requested that the obviousness of rejection of independent claims 1 and 27 be reconsidered and withdrawn.

However, the reasons for the patentability of the pending claims is not limited to those set-forth above with reference to independent claims 1 and 27. Indeed, numerous other distinguishing features and limitations recited in the respective dependencies of independent claims 1 and 27 are not addressed and have apparently been either completely or effectively ignored during the examination of this application.

For example, claim 3 requires that the information received by the first payment service provider, which indicates that the payee is associated with the second payment

network, be stored with a received unique identifier. A second request to make a second payment to the payee is received at the first payment service provider. The stored information indicating that the payee is associated with the second payment network is retrieved and a second payment instruction, including the retrieved unique identifier, is transmitted from the first payment service provider to the second payment service provider to make the second payment to the payee.

Claim 6 requires that one or more of the multiple payment networks be identified as candidate payment networks with which the payee may be associated, based upon the transmitted request. The inter-network directory provider transmits information indicating the one or more identified candidate payment networks to the first payment service provider.

Claim 7 requires that a request to the second payment service provider be transmitted to determine if the payee is associated with the second payment network. Also required is that the received information, indicating that the payee is associated with the second payment network, be received from the second payment service provider in response to the transmitted request to determine if the payee is associated with the second payment network.

Claim 8 recites that the received information indicating that the payee is associated with the second payment network includes information identifying the payee as one candidate payee and at least one other payee as another candidate payee associated with the second payment network. The second payment service provider identifies the payee as a candidate payee and the at least one other payee as another candidate payee, based upon the received request. Prior to transmitting the payment

instruction, it is determined that the one candidate payee, and not the at least one other candidate payee, is the payee based upon at least one of 1) information included in the request transmitted to the second payment service provider, and 2) the received information identifying the one and the at least one other candidate payees.

Claim 9 recites that the payer is associated with the first payment network, the request to make a payment on behalf of the payer is received from the payer, and the determination that the one candidate payee is the payee is made by the payer. The received information identifying the one and the at least one other candidate payees is transmitted to the payer. The determination that the one candidate payee is the payee, is received from the payer at the first payment service provider.

Claim 10 requires that the determination that the one candidate payee is the payee is made by the first payment service provider.

Claim 11 recites that a request is transmitted to a third payment service provider associated with the third payment network to determine if the payee is associated with the third payment service network. The payee is determined not to be associated with the third payment service network responsive to the request to the third payment service provider, and the result of this determination is transmitted by the third payment service provider to the first payment service provider.

Claim 12 requires that the received information from the inter-network directory provider include information indicating that the second payment service provider requires secured communications. A certificate authority is accessed to retrieve an encryption key associated with the second payment service provider. The request

transmitted to the second payment service provider is encrypted with the encryption key prior to transmission of the request.

Claim 13 requires that the received information indicating that the payee is associated with the second payment network is a positive declaration that the payee is associated with the second payment network.

Claim 14 recites that the inter-network directory provider stores information associated with each of the multiple payment networks and information indicating a network path over which to communicate with a certificate authority.

Claim 15 requires that the information stored by the inter-network directory provider is accessed and searched by the first payment service provider.

Claim 16 requires that the information stored by the inter-network directory provider is downloaded and searched by the first payment service provider.

Claim 17 recites that the received information indicating that the payee is associated with the second payment network is received from the inter-network directory provider and is a positive determination that the payee is associated with the second payment network.

Claim 18 recites that the request to determine the payment network with which the payee is associated is transmitted to the second payment service provider, and the received information indicating that the payee is associated with the second payment network is received from the second payment service provider.

Claim 19 requires that the request to make the payment on behalf of the payer is received from a third payment service provider, and that the payer and the third payment service provider are associated with a third payment network.

Claim 22 requires that funds from an account associated with the payer be transferred to an account associated with the first payment service provider. Funds from an account associated with the first payment service provider are transferred to an account associated with the second payment service provider. Funds from an account associated with the second payment service provider are transferred to an account associated with the payee.

Claim 24 recites that remittance advice associated with the payment is transmitted from the first payment service provider to the second payment service provider, and that this remittance advice is transmitted from the second payment service provider to the payee.

Claim 25 recites that the remittance advice transmitted from first payment service provider to the second payment service provider is structured according to a first message set, and that the remittance advice transmitted from the second payment service provider to the payee is structured according to a second message set different than the first message set.

Claim 26 requires that a determination be made at the second payment service provider, as to whether the payment instruction will be accepted, and that the results of the determination be transmitted to the first payment service provider and from the first payment service provider to the payer.

It is further respectfully submitted that the Examiner has failed to identify any teaching or suggestion, and the applied prior art lacks any teaching or suggestion within its teachings, of the above features and limitations. Furthermore, elements reciting similar features and limitations in the claim 27 dependencies (i.e. claims 28-52) also

further distinguish over the applied prior art for reasons which should be clear from the above.

Accordingly, it is respectfully requested that the obviousness of rejection of claims 2-26 and 28-52 also be further reconsidered and withdrawn on the additionally grounds presented above.

Claims 1, 5-10, 27 and 31-36 again stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 53-72 of co-pending U.S. Application S/N 09/984,568. The rejection is respectfully traversed.

The traversal arguments presented in the request for reconsideration filed on March 20, 2003 are incorporated herein in their entirety.

As understood, the rejection is based on the conclusion that claims 53-72 recite the same system and method as that of the provisionally rejected claims, and are distinguishable only on the basis of an intended use (i.e. the present application being directed to payment and the '568 application being directed to bill presentment).

However, it is respectfully submitted that this is not the case. While it is acknowledged that the Examiner is correct in stating that the intended usages of the inventions are different, recited features and limitations distinguish the present claims from those of the '568 application.

In the Response to Arguments on page 4 of the Official Action, the Examiner contends that the applied Thomas patent evidences that it was well known to use the same system and method for both bill payment and bill presentment. However, this is incorrect, as Thomas is directed only to bill payment and does not disclose a system or method for electronic bill presentment.

Claim 1 of the present application requires that a payment instruction be transmitted from a first payment service provider to a second payment service provider.

Claim 53 of the '568 application, on the other hand, requires that an activation instruction (not a request for presentment of a bill) be transmitted from the first billing service provider to a second billing service provider.

If, for the sake of argument, we assume that the payment and billing service providers are the same, this difference is analogous to, for example, claims in two applications one of which recites transmitting an encoded message (i.e. a message encoded in accordance with a first type encoding) for a first purpose from a first entity to a second entity, and another of which recites transmitting a differently encoded message (i.e. a message encoded in accordance with a second type encoding ) for a second (i.e. different) purpose from the first entity to the second entity.

In such a case, it seems unlikely that one would ignore the difference in the encoding of the messages (i.e. the differences in the messages) in determining whether one claim made obvious the other. Rather, the question, for purposes of obviousness type double patenting, would be whether or not the transmittal of the message encoded in the first type encoding suggests the transmittal of the message encoded in the second type encoding, or visa versa. If not, the inventions are distinct and therefore not subject to an obviousness type double patenting rejection.

Likewise here, the differences in the messages cannot simply be ignored. Rather, the question, for purposes of obviousness type double patenting, is whether or not the transmittal of the payment instruction message the transmittal of the activation instruction message. If not, the inventions are distinct and therefore not subject to an

obviousness type double patenting rejection.

In this regard, while the recited methods are related, they can be (and often are) performed independently. That is, there is no requirement that electronic bill payment always be performed in conjunction with electronic bill presentment, or that electronic bill presentment always be performed in conjunction with electronic bill payment.

Furthermore, to support obviousness type double patenting, one must conclude that the transmittal of the payment instruction message suggests the transmittal of the activation instruction message, or that the transmittal of the activation instruction message suggests the transmittal of the payment instruction message. It is respectfully submitted that there is no such suggestion.

First, the issuance of a payment instruction to pay a bill, on its face, lacks any suggestion of issuing an activation instruction to activate a biller to electronically present a bill, and visa versa.

Additionally, in the case of payment, there is no need to issue an activation instruction to activate a biller, because a biller can be electronically paid by the payer without ever being "activated" by a service provider to electronically receive bill payments from the payer. Also, in the case of payment, there is no need for the payer to receive an electronic bill to make an electronic payment, because a payment instruction can be issued to pay the biller without the biller ever providing an electronic bill to the payer (in fact this remains the case in many electronic payments today).

Furthermore, in the case of bill presentment, there is no need to issue a payment instruction to pay the biller, because the biller can be "activated" for electronic presentment of a payer's bill by a service provider without the biller ever receiving an

electronic payment from the payer. Further still, in the case of bill presentment, there is no need to issue any instructions to the biller's service provider (i.e. the second billing service provider) once the biller has been activated, because after activation the payer's bills will be made available at the payer's service provider (i.e. the first billing service provider) for electronic presentation to the payer.

Hence, claim 1 of the present application and claim 53 of the '568 application respectively recite unobvious limitations, and hence different (i.e. distinct) methods.

As the basis for the obviousness-type double patenting rejection has not been argued on a claim-by-claim basis, other features which distinguish claims 5-10, 27 and 31-36 are not individually discussed herein.

Accordingly, it is respectfully requested that the provisional obviousness-type double patenting rejection be reconsidered and withdrawn.

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

Our Ref.: 3350-0089  
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PATENT

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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